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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/550,817	09/23/2005	Stefan Jatzke	TRW(AEC)7821	1774
26294 7590 01/21/2010 TAROLLI, SUNDHEIM, COVELL & TUMMINO L.L.P. 1300 EAST NINTH STREET, SUITE 1700 CLEVEVLAND, OH 44114			EXAMINER SMALLEY, JAMES N	
			ART UNIT 3781	PAPER NUMBER
			MAIL DATE 01/21/2010	DELIVERY MODE PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/550,817	Applicant(s) JATZKE ET AL.	
	Examiner JAMES N. SMALLEY	Art Unit 3781	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 23 October 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-8 and 11-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 11-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 5-8, 11 and 13 are rejected under 35 U.S.C. 102(b) as being anticipated by Willibald EP 0631923.

Examiner has provided a machine translation of this document, obtained online at Yahoo Babel Fish. The English abstract of Willibald '923 teaches a central closure section (10) and an engaging section (20), a surrounding lip (6), and a sealing lip (4). Examiner notes the claim is drawn to the plug for sealing holes in a vehicle body (emphasis added), and thus the claim is read to be only drawn to the plug, with the intended use of being applied to a vehicle. Therefore, the prior art device must only be capable of being used in the intended manner. Examiner asserts the device of Willibald '923, because it teaches all the claimed structural features of the instant invention, is thus capable of being used in the intended manner. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987).

Examiner notes the translation, page 2, second-to-last sentence, which states “The sealing rim 4 subjected here the top [sic] side of the mother board and is stuck together at a certain temperature with the mother board...” Examiner hold this to be evidence of heat sealing, as the English abstract describes an adhesive connection. Examiner further asserts that any adhesive is at least slightly capable of being softened by heat, and even furthermore the fact that the Abstract discloses both are formed of plastics indicates they can clearly be softened by heat. Examiner further notes the last sentence, which continues to the next page, noting that stop ring 6 prevents the plug from being “...pulled or squeezed out.” Thus, regarding claims 2 and 5, the device is capable of producing an interlocking fit.

Regarding claim 6, the embodiment of figure 1 teaches the claimed shape.

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Regarding claim 7, Examiner notes in the embodiment of figure 1, the annular recess located above ring (6) and below rim (4) is directed radially inwardly, and thus inherently comprises an interlocking fit between central closure section (10), and engaging section (20).

Regarding claim 8, Examiner notes the embodiment of figure 1 teaches the claimed structure, as a first surface is against the outer surface of the hollow cylindrical section (at 5) and the second surface (4) extends beyond the rim of the closure section (10).

Regarding claim 11, the embodiment of figures 1 or 2 shows a U-shaped cross section between lips 4 and 6.

Regarding claim 13, the embodiment of figure 3 shows the open end being being free of the engaging section (20).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Willibald EP 0631923.

Willibald '923 fails to explicitly teach the use of gluing to secure the closure section and engaging sections together.

Examiner takes Official Notice it would have been obvious to one having ordinary skill in the art at the time the invention was made to secure the two elements together by gluing to ensure the two elements stayed together before use.

Examiner further notes that Applicant failed to present any arguments with respect to this ground of rejection, in the reply filed October 23, 2009, and thus the rejection becomes admitted prior art.

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5. Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Willibald EP 0631923 in view of Schmitz US 4,588,105.

Willibald '923 teaches all limitations substantially as claimed, but fails to teach the melt temperature of the sealant occurring between 150 and 200 degrees Celsius.

Schmitz '105 teaches a plug for an opening in an automobile panel, and discloses in column 4, line 18 that the melting can occur anywhere between 85 and 180 degrees Celsius. It would be desirable to use this material on the plug of Sick '022, which only teaches melting occurring between 100 and 135 degrees Celsius, in order to provide the manufacturer with a greater range of temperature operation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to modify the plug of Sick '022, providing the sealant taught by Schmitz '105, motivated by the benefit of providing the manufacturer with a greater temperature range of operation. Furthermore, Examiner notes it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. *In re Aller*, 105 USPQ 233.

Response to Arguments

6. Applicant's arguments filed October 23, 2009 have been fully considered but they are not persuasive.

Applicant argues that because the plug of Willibald is formed with a spraying process, it fails to meet the limitation of the engaging section being inserted into the closure section.

Examiner notes the limitation is a method recitation within the scope of an apparatus claim. Thus, the method is only treated to the degree it materially affects the final product. Regarding the Willibald plug, the harder middle or nuclear section ultimately lies within upper and lower layers of the outer coating, and at least in this sense is "inserted" or located between the layers. It has been held that method limitations in a product claim do not serve to patentably distinguish the claimed product from the prior art. See *In re Thorpe*, 777 F.2d 695, 227 USPQ 964 (Fed. Cir. 1985). Thus, even though a product-by-process claim is limited and defined by a process, determination of patentability is based on the

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product itself. Accordingly, if the product in a product-by-process claim is the same or obvious from a product of the prior art, the claim is unpatentable even though the prior art product was made by a different process. *Thorpe*, 777 F.2d at 697, 227 USPQ at 966; *In re Marosi*, 710 F.2d 799, 218 USPQ 289 (Fed. Cir. 1983).

Applicant argues Willibald fails to teach an engaging section that includes both a surrounding sealing lip and a further sealing lip that engage opposite sides of the edge of a hole.

Examiner notes Applicant argues that because the embodiment of figure 3 lacks a coating, that lip (6) cannot form a seal. Examiner disagrees, and further points out that the arguments are silent with respect to the coated form in figures 1 and 2. Even if there is no coating, Examiner asserts that lips (4, 6) because of their axial displacements relative to one another, are capable of forming a seal. The claims do not limit the quality of the seal. Applicant's arguments are mostly drawn to the differences between the two plugs themselves; however, Examiner notes that this is not the determination of patentability, but instead how closely the prior art meets the claimed invention. Examiner asserts that the plug shown in figures 1, 2, or 3 could form a seal on both sides of the opening of a hole in a Panel. Examiner further points to the English machine translation provided, which notes on page 2 of 5, "The stop ring 6 faces 3, i.e. the sealing rim 4, in for instance the outer ring, so that between these two ranges the top side and the lower surface of a mother board not represented more near are enclosed" (sic). In other words, the top and bottom surfaces of the mother board, which is not pictured, would be located between 6 and 4.

Lastly, Examiner notes the claim is drawn to the plug, for the intended use of sealing holes in a vehicle body, and that the vehicle body is not positively claimed. Therefore, patentability is based on the product itself, and not the combination. By having sealing flanges which are at the very least capable of performing in the intended manner, the reference anticipates the claimed invention. It has been held that a recitation with respect to the manner in which a claimed apparatus is intended to be employed does not differentiate the claimed apparatus from a prior art apparatus satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Furthermore, if a prior art structure is capable of performing the intended use as recited in the preamble, then it meets the claim. See, e.g., *In re Schreiber*, 128 F.3d 1473, 1477, 44 USPQ2d 1429, 1431 (Fed. Cir. 1997).

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Allowable Subject Matter

7. Claim 12 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JAMES N. SMALLEY whose telephone number is (571)272-4547. The examiner can normally be reached on Monday - Friday 10 am - 7 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Stashick can be reached on (571) 272-4561. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Anthony Stashick/
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